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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,605	04/30/2001	Akira Ichikawa	Q64273	9350

7590

03/03/2006

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EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/830,605

Applicant(s)

ICHIKAWA ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/30/2005 has been entered. The Examiner has carefully considered Applicants' amendments to claims 1, 4-8, 10, 12 and 14. Cancellation of claim 15 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Rejections Based on Prior Art***

4. Claims 1, 2 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimura et al. (US 6065701) in view of Applicants' admission, generally as set forth in section 4 of Office action mailed 9/1/2005, together with the following additional reasoning and response to argument.

First, in response to the amendments, the Examiner points out the corresponding (see underlined) relied upon prior art as follows: Tanimura's invention relates to a label

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comprising an integrated circuit (IC), which comprises a memory unit (data carrier) and a signal processing unit (Abstract). Fig. 2 shows that the adhesive label has an antenna wiring (antenna coil) 30 and an IC 20 formed on a polyimide substrate 16, a “both faces adhesive material” (double sided) adhesive layer 17, and an exfoliative paper (release layer) 18. The adhesive layer 17 adheres the label to a video cassette tape (column 4, lines 7-8). Tanimura also teaches a coated paper layer 12 as an outer surface layer for carrying information such as the title, recording date, and recording place of the video tape (column 3, lines 52-56). A non-contact (contactless) system used for the transfer of data to the semiconductor memory (column 2, lines 15-17). It is noted that Tanimura lacks an express teaching that the adhesive layer 17 is formed on a substrate surface which is in direct contact with the electronic component. However, Applicants have admitted in the “Background Art” section that “... a typical conventionally used carrier has a structure ... an entire contactless data carrier element is formed on one side of the circuit substrate ... Alternatively, the contactless data carrier element may be prepared by separately forming a part of an electric circuit on each side of the circuit substrate, and connecting one to the other via a through-hole, to thus integrate the separately formed parts into a sole contactless data carrier element” (specification, pages 1-2, bridging paragraph). As such, the combined teachings of Tanimura and Applicants’ admission render the instant invention obvious. In particular, it should be noted that the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

With respect to Applicants' argument "... "electric circuit" and "electronic components" ... are two distinct and mutually exclusive terms ..." (Remarks, page 9, second paragraph), and the statement "In the present Amendment, Applicants have amended the claims to clearly recite "an IC chip" and "antenna coils," rather than "electronic components" and "electric circuit." (Remarks, page 13, last full paragraph), the Examiner notes: 1) Applicants' clarifying amendment is appreciated. 2) Tanimura's teaching of each of the amended elements is identified (see underlined) in the above paragraph, and Tanimura in view of Applicants' admission continues to render the instant invention obvious, as set forth above.

Applicants' argument "... what was known in the art was the contactless data carrier element prepared by separately forming a part of an "electric circuit", i.e., antenna coils, on each side of the circuit substrate. However, there is no description that the contactless data carrier prepared by separately forming a part of "electronic components" on each side of the circuit substrate was known ... the phrases "electric circuit" and "electronic components" are used as two distinct and mutually exclusive terms throughout the present specification" (Remarks, page 14, bottom paragraph) has been carefully considered, but is not persuasive. The Examiner would like to again quote Applicant admission "... a typical conventionally used carrier has a structure ... an entire contactless data carrier element is formed on one side of the circuit substrate ... Alternatively, the contactless data carrier element may be prepared by separately forming a part of an electric circuit on each side of the circuit substrate, and connecting one to the other via a through-hole, to thus integrate the separately formed parts into a

sole contactless data carrier element", and points out that even if the phrases "electric circuit" and "electronic components" are distinct and mutually exclusive, Applicants' admission also clearly suggests that separately formed parts (components), including an IC chip, can be at either side of the substrate. Applicants' argument to the contrary is not persuasive.

With respect to Applicants' argument "... in Fig. 3 of the present specification ... adhesive layer 5 is not in direct contact with the entire carrier element ... in Tanimura ... the adhesive layer 17 is not in contact with the electronic components ... even if there might be motivation to combine Tanimura et al with "Applicants' admission," the resulting structure would still not be the present invention ..." (Remarks, page 15, middle paragraph), the Examiner notes: 1) Nowhere has the Examiner relied upon the structural relation in Fig. 3 as the basis of rejection. Applicants' argument appears to be misplaced. 2) It has been well settled that the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. More particularly, since Applicants' admission points out alternative equivalent structural relations as claimed are known, in the absence of unexpected results, it is *prima facie* obviousness to one of ordinary skill in the art to select an alternative equivalent known embodiment.

With respect to Applicants' argument "... the present invention provides a thin adhesive label-type contactless data carrier which can eradicate the influence of the irregular or uneven structure due to the presence of electronic components, particularly an IC chip, on a flat circuit substrate ... has advantageous effects over Tanimura in that

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it is thinner ... can be manufactured with fewer steps ... lower manufacturing cost ... achieved commercial success ...” (Remarks, page 16, middle paragraphs), the Examiner notes: 1) Applicants' have not provided any comparative data. In the absence factual support, Applicants are reminded that attorney's argument cannot take place of evidence. 2) The thickness of the label is absent from the claims of instant application. 3) The manufacturing steps are not being claim, and even if it is claimed, Applicants must show that the resultant article is patentably distinct. 4) The manufacturing cost bears no patentable weight. 5) For commercial success to be persuasive, a nexus must be shown between the difference exhibited over the prior art and the success enjoyed, but no factual support has been provided.

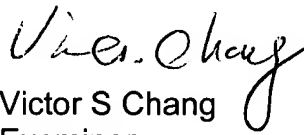
### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

2/28/2006